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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/202,244	02/19/1999	STEFAN BREUNIG	022701-803	2643

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BURNS DOANE SWECKER & MATHIS L L P
POST OFFICE BOX 1404
ALEXANDRIA, VA 22313-1404

EXAMINER

MOORE, MARGARET G

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 12/04/2002

31

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/202,244

Applicant(s)

BREUNIG ET AL.

Examiner

Margaret G. Moore

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1712

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 November 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 22 to 25, 27 to 34, 36 to 45 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 22 to 25, 27 to 34, 36 to 45 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

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1. Claims 43 and 44 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The presence of the negative proviso (that the synthon is not a hydroxylated synthon) is not supported by the written description. The specification exemplifies one synthon having a hydrocarbon comprising ring in which is included at least one oxygen atom and hydroxyl groups but this fails to describe the invention as is now claimed. On a broader level, note that since the synthons "comprise" at least one hydrocarbon containing ring in which is included at least one oxygen atom (using open language) and the proviso is directed to all of the synthons generally, this proviso excludes compounds that contain a hydroxyl group but do not contain a hydrocarbon ring having at least one oxygen atom, something that is not at all described in the specification. Please note MPEP 2173.05(i), particularly the third paragraph.

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 22, 24, 25, 27 to 30, 32, 41 and 43 to 45 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Jachmann et al.

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5. Claims 34 and 36 to 38 are rejected under 35 U.S.C. 102(b) as being anticipated by Jachmann et al.

6. Claims 23, 30, 31, 33, 39, 40 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jachmann et al.

7. These rejections are consistent with the rejections made in the previous office actions and as such the rationale behind them will not be repeated. Applicants' traversal of these rejections is not persuasive. Applicants first state that they believe the reactions of Jachmann et al. are conducted in the presence of a homogeneous catalyst. However as noted in previous office actions, Jachmann et al. specifically teach only 3 catalysts, one of which is platinum on charcoal, meeting the claimed heterogeneous catalyst. See column 8, line 63.

Regarding applicants' allegations of unexpected results, the Examiner notes that showings of unexpected or improved results cannot be used to overcome a rejection under 35 USC 102. With regards to the rejections under 35 USC 103, the Examiner notes that mere allegations of improved results are insufficient to distinguish over the prior art. In addition, the specification does not seem to support allegations of criticality in the selection of a catalyst. Furthermore on an initial review, the Examiner questions whether these results are in fact "unexpected" or properties that would have been expected from a heterogeneous catalyst in view of the fact that it can be readily removed from the reaction system and thus will not provide any negative side effects.

The Examiner notes that none of these arguments would appear to have an affect on the patentability of the product claims.

With regards to applicants' comments on page 14 of their response, regarding the "two stage" reaction described by patentees in which the epoxy siloxane is formed prior to reaction with a hydroxyl containing compound, the Examiner cites that noted on the bottom of page 3 through page 3 of the Advisory Action dated 10/1/02 as it applies.

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8. Claims 22, 24, 25, 27 to 32, 34, 36 to 41 and 43 to 45 are rejected under 35 U.S.C. 103(a) as being unpatentable over Koshar et al. in view of Chandra et al. or Jachmann et al.

Koshar et al. teach epoxysiloxanes. See for instance column 4, lines 41 to 55, which teaches the hydrosilylation reaction between an epoxy compound (i.e. applicants' synthon) and an SiH containing siloxane. Particular attention is drawn to Example 1 which uses a siloxane meeting the general formula (XVI). The synthon in this reaction meets formula (IX) in claim 45. This reaction differs from that claimed in that it uses chloroplatinic acid as a catalyst rather than the heterogeneous catalyst claimed.

Chandra et al. teach platinum catalysts on a silicate carrier. Column 4, lines 14 to 20, teaches that these catalysts are particularly useful for hydrosilylation reaction. The bottom of column 4 teaches that these catalysts offer an advantage over a chloroplatinic acid catalyst because they are easily recovered from reaction residues.

The bottom of column 8 in Jachmann et al. teach that chloroplatinic acid and platinum on charcoal catalysts can be used in the alternative as hydrosilylation reaction catalysts.

Thus one having ordinary skill in the art would have been motivated by the teachings of Jachmann et al. to use platinum on charcoal in place of the chloroplatinic acid catalyst used in Koshar et al. with a reasonable expectation of success in view of their implied functional equivalence, as taught by Jachmann et al.

On the other hand, one having ordinary skill in the art would have been motivated by the teachings of Chandra et al. to use the supported catalyst taught therein in place of the chloroplatinic acid catalyst used in Koshar et al. in an effort to take advantages of the properties and benefits thereof, as taught by Chandra et al.

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret G. Moore whose telephone number is 703-308-4334. The examiner can normally be reached on Mon., Wed., Thurs. and Friday, 10am to 4pm..

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson can be reached on 703-308-2340. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9311 for regular communications and 703-872-9310 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Margaret G. Moore
Primary Examiner
Art Unit 1712

mgm
November 29, 2002